

Attorney Docket No. 9368-5

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Smith et al.

Group Art Unit: 1648

Patent No. 7,442,381 B2

Issue Date: October 28, 2008

Application Serial No.: 10/804,331

Examiner: B. Blumel

Filing Date: March 19, 2004

Confirmation No.: 7017

For: ALPHAVIRUS REPLICONS AND HELPER CONSTRUCTS

Date: December 23, 2008

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**APPLICATION FOR REVISION OF PATENT TERM ADJUSTMENT**

Sir:

Pursuant to 37 C.F.R. § 1.705(d), Applicants submit this application for revision of patent term adjustment (PTA) for the above-referenced U.S. Patent No. 7,442,381 ('381 patent), issued October 28, 2008.

Pursuant to 37 C.F.R. § 1.705(b)(1), provided herewith is authorization to charge Deposit Account No. 50-0220 in the amount of \$200.00 as the fee set forth under 37 C.F.R. § 1.18(e).

Pursuant to 37 C.F.R. § 1.705(b)(2) provided below is the following statement of facts.

(i) Assuming the current PTA calculations as provided in PAIR are correct in showing 923 days of delay on applicants' part and 745 days of delay on the PTO's part (which applicants also believe to be incorrect as explained below), the corrected patent term adjustment for the '381 patent should be an additional 588 days, which is the number of days from March 19, 2007, which is three years after the March 19, 2004 filing date of this patent, to October 28, 2008, which is the issue date of this patent. This additional patent term is appropriate pursuant to 35 U.S.C. § 154(b)(1)(B) and the above calculation is correct pursuant to the recent holding by the U.S. District Court, District of Columbia in *Wyeth et al. v. Dudas* (2008 WL 4445642 (D.D.C.) (copy enclosed). Specifically, the Court in *Wyeth et al.* has established that the proper calculation for PTA is the sum of any PTO delays pursuant to 35 U.S.C. § 154(b)(1)(A) AND any PTO delays pursuant to 35 U.S.C. § 154(b)(1)(B), minus any delays on the part of the applicant. The basis for this adjustment is provided pursuant to 37 C.F.R. § 1.702(b).

(ii) The relevant dates as specified in 37 C.F.R. § 1.703(b) are the filing date of March 19, 2004, the three year post-filing date of March 19, 2007, and the patent issue date of October 28, 2008. The adjustment as specified pursuant to 37 C.F.R. § 1.703(f) to which the '381 patent is entitled, as set forth above, is therefore 588 days.

(iii) The '381 patent is not subject to any terminal disclaimer.

(iv) Circumstances during the prosecution of the application resulting in the '381 patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704 are described in the PTA calculation sheet for the '381 patent (copy enclosed), showing 745 days of delay attributable to the PTO and 923 days of delay attributable to applicants, presently providing 0 days of PTA for the '381 patent.

Accordingly, in response to this application for PTA as timely filed within two months of the October 28, 2008 issue date of the '381 patent pursuant to 37 C.F.R. § 1.705(d), applicants request that the '381 patent be accorded the correct PTA of 588 days.

Furthermore, applicants wish to point out an error in the calculation of 821 days of delay for the time period from September 27, 2004 to March 28, 2007 attributable to the applicants as shown in PAIR. In particular, the applicants received a Notice of Incomplete Nonprovisional Application mailed September 27, 2004. Applicants filed a Response to Notice of Incomplete Nonprovisional Application on November 24, 2004, which included 1) an executed Declaration and Power of Attorney, 2) a copy of a Sequence Listing in computer readable form (on diskette) and in paper copy (12 pages) and a statement asserting that the content of these is the same (one page), 3) a copy of a Petition to Grant a Filing Date for a Complete Non-Provisional Application and accompanying documents as filed on November 24, 2004 (seven pages), 4) a copy of the Notice; and 5) a check in the amount of \$65.00 for the surcharge for filing the Declaration under 37 C.F.R. § 1.16(e), as required pursuant to the Notice of Incomplete Nonprovisional Application.

The PTA Adjustment History for the '381 patent shows the following entries dated 11-24-2004:

11-24-2004      Workflow incoming petition IFW

11-24-2004 Petition Entered  
11-24-2004 A statement by one or more inventors satisfying the requirement under 35 USC  
115, Oath of the Application  
11-24-2004 A set of symbols and procedures, provided to the PTO on a set of computer  
listings...  
11-24-2004 CRF Disk has been Received by Preexam/Group/PCT  
11-24-2004 Additional Application Filing Fees  
11-24-2004 Petition Entered.

The next six entries in the PTA Adjustment History are as follows:

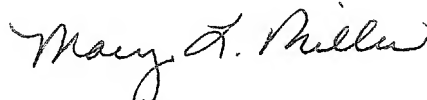
08-01-2006 Mail-Record Petition Decision of Granted Related to Filing Date  
09-27-2004 Pre-Exam Office Action Withdrawn  
03-05-2007 SEQUENCE ERRORS  
04-04-2007 CRF is Good Technically / Entered into Database  
03-28-2007 CRF Disk Has Been Received by Preexam / Group/ PCT  
03-28-2007 Additional Application Filing Fees

These entries cover the period of time from September 27, 2004 to March 28, 2007, which is identified on the PTA Adjustment History log as a period of delay of 821 days attributable to the applicants. Applicants assert that this calculation is in error, as the record shows that a response to the September 27, 2004 Notice of Incomplete Nonprovisional Application was timely submitted on November 24, 2004, with all of the required documents and fees. The error appears to be due to the second entry of "Additional Application Filing Fees." Thus, these 821 days have been incorrectly attributed to a delay by the applicants and should be removed. The correct number of days attributable to any delay by applicants should therefore be 102 days, which subtracted from the PTO's 745 days of delay, provides an additional 643 days of patent term. This 643 days should be added to the 588 days as calculated above due to issuance of the patent beyond three years from the filing date, for a total of 1,231 days of additional patent term. Thus, applicants respectfully request revision of the patent term adjustment for this patent to add this amount of additional patent term.

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The Commissioner is authorized to charge Deposit Account No. 50-0220 in the amount of \$200.00 as the fee set forth pursuant to 37 C.F.R. § 1.18(e). This amount is believed to be correct. However, the Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-0220.

Respectfully submitted,

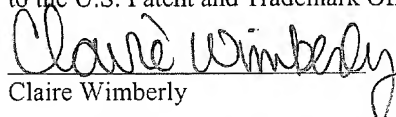


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**CERTIFICATION OF ELECTRONIC TRANSMISSION**

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on December 23, 2008.

  
Claire Wimberly